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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,714	06/04/2001	Morenike Awokola	FA1002 US NA	4978

23906 7590 03/22/2004

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LEGAL PATENT RECORDS CENTER  
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WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/873,714	Applicant(s) AWOKOLA ET AL.	
	Examiner Elena Tsouy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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***Response to Amendment***

Amendment filed on February 19, 2004 has been entered. Claim 7 has been cancelled.

Claims 1-6, 8-10, 13 are pending in the application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 8, 13** rejected under 35 U.S.C. 103(a) as being unpatentable over DE-A-197 57 082 or WO 99/26733 in view of Takeda et al (US 4,615,915), and further in view of Brehm et al (US 5,596,043) for the reasons of record as set forth in Paragraph Nos. 2 and 4 of the Office Action mailed on November 17, 2003 since claim 1 has been amended to include the limitations of claim 7.
3. **Claims 1-6, 8, 9, 10, 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over DE-A-197 57 082 or WO 99/26733 in view of Richard (US 5,091,211), and further in view of Brehm et al (US 5,596,043) for the reasons of record as set forth in Paragraph Nos. 3 and 4 of the Office Action mailed on November 17, 2003 since claim 1 has been amended to include the limitations of claim 7.

***Response to Arguments***

4. Applicants' arguments filed February 19, 2004 have been fully considered but they are not persuasive.

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(A) Applicants argue that Takeda et al is not combinable with DE-A-197 57 082 because Takeda et al disclose the use of thermosetting resins, and there is no suggestion in Takeda et al that the thermosetting resins are compatible with high energy radiation curable compositions.

DE-A-197 57 082 discloses that in addition to the radiation-curable binders, the surfacer coating composition further comprises chemically cross-linkable binders, which are cured by the heat generated by UV flash lamps (See column 6, lines 53-59). In other words, the surfacer coating composition of DE-A-197 57 082 comprises both the radiation-curable binders and heat curable chemically cross-linkable binders, i.e. **thermosetting** binders such as epoxy-amino resin (See column 4, line 35). DE-A-197 57 082 further teaches that the temperatures generated on the coating by means of the UV irradiation (UV flash lamp) are generally sufficient to cure the additional cross-linkable binders. No separate curing operation is necessary. See column 6, lines 56-59. Takeda et al are applied to show that phosphoric acid esters can be used for acceleration of curing **thermosetting** epoxy-amino resins (See column 3, lines 39-43, 56-59). Since DE-A-197 57 082 shows that curing of the thermosetting epoxy-amino resins by heat generated by UV flash lamps occurs independently from radiation curing of radiation-curable binders by the UV flash lamps, i.e. is not affected by the presence of radiation-curable binders, one of ordinary skill in the art at would have reasonable expectation of success in using phosphoric acid esters of Takeda et al to accelerate curing of the thermosetting epoxy-amino resin while curing by UV lamps the radiation-curable binders in the surfacer coating composition of DE-A-197 57 082.

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(B) Applicants argue that Richard is not combinable with DE-A-197 57 082 because Richard is directed to plastic substrates while claim 1 is amended to limit the substrates to metal substrates.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves: DE-A-197 57 082 teaches that *preferred* substrates for coating with radiation-curable surfacer coating composition are metal **or** *plastic* substrates (See column 5, lines 24-25). Therefore, Richard directed to plastic substrates, is combinable with DE-A-197 57 082.

(C) Applicants argue that Brehm et al cannot be combined with DE-A-197 57 082 in view of Richard or DE-A-197 57 082 in view of Takeda et al because (i) Brehm et al disclose a coating agent for scratch-free coatings on thermoplastic substrates (col. 6, lines 33-35), and there is no suggestion in Brehm et al that monofunctional reactive thinners can be utilized in coatings for metal substrates; (ii) the coatings in Brehm et al can only be applied in a thickness of 1-50 microns (col. 6, line 66-col. 7, line 1) whereas coatings produced by Applicant's claimed process

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have no such limitation (see Example 3 of specification demonstrating coating thickness of 150 microns).

As to (i), first of all, Brehm et al are applied to show that monofunctional reactive thinners, such as isobornyl methacrylate (See column 5, line 59) may be used in combination with acrylic prepolymers (See column 4, lines 5-13) in a radiation curable coating composition (See column 7, lines 14-25) for coating automobile parts (See column 6, lines 33-35, 42) to provide good flow properties of the coating composition and thereby good processibility (See column 5, lines 50-53). Therefore, one of ordinary skill in the art at would have reasonable expectation of success in using isobornyl methacrylate as methacrylate diluent in a radiation curable coating composition of DE-A-197 57 082 in view of Richard or DE-A-197 57 082 in view of Takeda et al to provide good flow properties of the coating composition and thereby good processibility, no matter what substrates they are applied thereto.

Secondly, just like DE-A-197 57 082 teaches that a radiation curable coating composition comprising monofunctional reactive methacrylate thinner in combination with acrylic prepolymers can be used for coating plastic substrates (See column 5, line 25), Brehm et al also teach that a radiation curable coating composition comprising isobornyl methacrylate in combination with acrylic prepolymers may be used for coating plastic substrates (See column 6, line 38).

As to (ii), in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., coating thickness of 150 microns) are not recited in the rejected claim(s). Although the claims

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are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read 'ETsoy'.

Elena Tsoy  
Examiner  
Art Unit 1762

March 16, 2004